

Remarks and Arguments:

Claims 1 to 9 and 13 to 15 are cancelled and claim 16 has been amended. Accordingly, claims 10 to 12 and 16 remain for consideration in this application. The above amendments and the following remarks are submitted as a full and complete response to the Office Action of 12/10/2007.

New independent claim 16

New independent claim 16 is directed to a stand-alone portable garden power supply for powering an external device having a power cord. The garden power supply comprises, *inter alia*, a massive body having an irregular shape resembling a natural boulder and an external surface portion in the form of a planar face angled upwardly at an angle of about 45°. On the external surface portion, there is an exposed flat solar electricity-producing panel which generates an electrical current in the presence of solar radiation, said flat solar electricity producing panel being angled upwardly at an angle of about 45°. The claim specifically recites that the external surface is flat so as to support the solar panel on the irregular surface. A DC power outlet pluggably receives the power cord of the external device to provide DC power from said rechargeable battery to power the external device.

The invention of claim 16 provides a highly useful power supply. Some landscapes and gardens are quite elaborate, incorporating many features and accessories. There can be quite a problem if, for example, a gardener wants to incorporate a waterfall in the middle of a garden at a location that is distant from an outlet. How is the pump for this waterfall powered? Using a long extension cord from the pump to a distant outlet is quite unsafe if the extension cord is not buried in the ground and quite inconvenient if it is buried. By ensuring that the power supply is portable, the gardener has much more flexibility and versatility in situating the power supply at desired locations. Also since the power supply is a stand-alone device, it does not use a power cord and as such can be placed in any desired location.

The invention of claim 16 provides a power supply having a DC outlet that can pluggably receive a power cord from an external separate device such as the exemplary pump. In this way, the power supply can be located close to the external device to be powered, mitigating the inconvenience and danger of a trailing power cord. But even further, the power supply is in the form of a massive stable base which can be selectively moved about from one location to another as the landscape design dictates. This is advantageous over systems using stakes or the like to support a solar panel; stakes must be secured into the ground to provide the needed support and must be dug out in order to move or relocate the device.

Even further, the massive stable base has a flat planar surface angled at 45° so that a solar panel can be secured thereto. The solar panel is then also angled at 45°, which is the median elevation of the sun. This angle and the fact that the power supply can be moved about further provides for the possibility of increased exposure to the sun, which in turn increases and improves the efficiency of the power supply itself. For additional efficiency, the power supply defined in claim 16 also includes a rechargeable battery. Clearly all of the features of the claimed power supply codependent to provide a highly useful power supply in the art of gardening and landscaping.

As yet a further advantage, the present power supply is in the form of a natural looking boulder. This is not only provides an aesthetically pleasing device for use in a garden, Applicant submits that it provides a useful function: by having the power supply in the form of a natural boulder, it is in a form that wildlife and birds are familiar with and comfortable with. As such, use of this power supply in a garden will not scare away wildlife and birds from the garden.

It appears that the Examiner seems to be glossing over the fact that the invention is a stand-alone power supply with a DC outlet. It is not a self-contained unit for providing light. The invention provides power to any external device via a DC outlet. The power supply in accordance with the invention harnesses solar power, stores it in a battery and provides it to an external device via a DC outlet. In this way, a need for long power cords/extension cords is negated since the inventive power supply can be situated

anywhere. Also the outward appearance as a boulder provides the added benefit of not scaring away wildlife and birds.

The Examiner has rejected claims 10 to 13 and 16 under 35 U.S.C. § 103(a) as being obvious in view of US Patent 6,932, 489 (Sooferian), a website entitled "Stanford Area Trails" (Stanford) and PG Publication 20020003697 (Chien). The Examiner has also rejected claims 10 and 11 under 35 U.S.C. § 103(a) as being obvious in view of Chien, Stanford and Sooferian. Applicant respectfully traverses these rejections.

Sooferian is directed to a stepping stone having a light source therein. The stepping stone of Sooferian is a self-contained unit; the light in the stepping stone is powered via a solar panel.

The Examiner agrees that Sooferian does not teach the recitations of a massive body with an external surface in the form of a planar face angled at about 45°, or the feature of a DC outlet for pluggably receiving the power cord of an external device.

It is noted that the Examiner continues to persist with the position that the stepping stone of Sooferian is a "rock" as was previously recited in claim 16. For improved clarity, Applicant has amended this term to read - - boulder --. It is submitted that a "stone" is very different than a "boulder". The commonly accepted definition of "boulder" is "a detached and rounded or worn rock, especially a large one". The present power supply in the shape of a boulder is clearly depicted in Figure 1 of the present application. Applicant submits that it is clear that the stepping stone of Sooferian is not a boulder as intended by the language of the present claims.

The Examiner is relying on a combination of Sooferian and Chien to lead one skilled in the art to modify the stepping stone of Sooferian to add a DC outlet based on the teachings of Chien. However it is submitted that one skilled in the art would not modify Sooferian to add a DC outlet based on the teachings of Chien.

Applicant submits that there is no reason to add a DC outlet to the stepping stone of Sooferian since the purpose of the system of Sooferian is to provide illumination of the stepping stone at night. The purpose of Sooferian is not to provide power to any external device as is the purpose of the presently claimed invention. Sooferian relates solely to a self-contained unit wherein the solar panel powers a light integral within the unit. In contrast, the present invention is directed to a power source for providing power from an "outlet" to an "external" device. This is a fundamental difference in use and application.

Thus Applicant submits that the combination of Sooferian and Chien cannot be the basis of a proper obviousness rejection. Indeed it is submitted that one skilled in the art would not modify Sooferian to add a DC outlet based on any teaching whatsoever because the goal of Sooferian is to provide a self-contained light and not to provide power to an external device.

The Examiner is also relying on an embodiment of Sooferian wherein electrical connectors join stepping stones together. However this embodiment is very different that a dedicated power supply having a DC power outlet to provide power to any external device as recited in new claim 16. Clearly the power supply of the present invention in the form of a DC outlet is much more versatile than a series of "electrically connected" stepping stones, since any external device with a power cord can be powered by the invention of present claim 16.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Further, Applicant submits that Chien does not even teach the use of a DC power outlet in the power supply. Chien teaches in Figure 1A that a wire 10 can extend outwardly in one embodiment to power other lights in a series circuit. This is clearly not a DC power outlet as claimed in present claim 16.

The Examiner is further relying on a combination of Sooferian and Stanford to lead one skilled in the art to modify the stepping stone of Sooferian to incline the solar panel to 45°C.

Applicant is puzzled by how the Examiner can cite Stanford, which is a proposal for various trail sites, to the art of garden accessories. Applicant submits that one skilled in the art would not combine Sooferian and Stanford to obtain the invention as claimed in claim 16 of the present invention, as they are not analogous art. References are considered to be analogous art if they are “reasonably pertinent to the particular problem with which the inventor is involved”. *Heidelberger Druckmaschinen AG v. Hantscho Commerical Prods., Inc.*, 21 F.3d 1068, 1072, 30 USPQ2d 1377, 1379 (Fed. Cir. 1994). The problem encountered by the present inventors is to maximize solar power in a power supply, which is achieved by inclining the solar panel by 45°. It is further drawn to the Examiner’s attention that new claim 16 specifically recites that the solar panel is located on “an external surface portion in the form of a planar face angled upwardly at an angle of about 45°”. This feature in conjunction with the massive solar body provides an advantageous system which can be moved and relocated as desired, for example to maximize sun exposure.

On the contrary, the art cited by the Examiner is a proposal for a trail; it is not directed to the art of garden accessories. In fact, Applicant understands that the use of a 45° incline in the trail is not considered to be a positive feature. “The existing ‘trail’ behind the guardrail...barely qualifies as a sidewalk let alone a recreational trail. It’s about a 10’ drop with a 45 degree slope” (page 5 of Stanford). Applicant submits that given the nature of the problems confronted by the inventors, one of ordinary skill in the art would not have consulted the cited references since they are not “reasonably pertinent”.

It is further noted that the Examiner believes that Stanford teaches that “the stepping stone is placed on a 45° sloping pathway”. The Examiner has not provided any indication where in Stanford this is disclosed. Applicant believes that it has been proven above that this is not the case. However, if the Examiner wishes to persist with this stand, Applicant

respectfully requests that the Examiner outline how this conclusion came about. This will permit Applicant to formulate a full and complete response thereto.

Clearly, a combination of Sooferian, Chien and Stanford is deficient in teaching or suggesting at least the recitations of: 1) a massive body in the shape of a boulder; 2) an external planar surface with an exposed flat solar electricity-producing panel which generates an electrical current in the presence of solar radiation, said flat solar electricity producing panel being angled upwardly at an angle of about 45°; and 3) a DC power outlet pluggably receives the power cord of the external device to provide DC power from said rechargeable battery to power the external device.

With respect to the first recitation (massive body in the shape of a boulder), Applicant submits that it is clear that none of the systems of the cited art are in the form of a boulder as intended by present claim 16. It is noted that the Examiner has agreed that Sooferian does not teach the use of massive body and has also failed to provide any argument or art asserting that this recitation is obvious. It is well established that in order to establish a case of obviousness under 35 USC 103(a) that a combination must teach all of the limitations of the claims (see MPEP 2143). Thus, Applicant concludes that new claim 16 reciting this feature is both novel and unobvious.

With respect to the second recitation (45° solar panel), the solar panel of Sooferian is not angled at all and there is no teaching or suggestion that the panel could be angled for any reason. It is submitted that a combination of Sooferian and Stanford is not a permissible basis for an obviousness rejection as they are not analogous art. Further, even if Sooferian and Stanford were combined, it is submitted that it would not lead one skilled in the art to incline the solar panel of Sooferian, as Stanford teaches that the use presence of an incline is actually something that is not desired.

With respect to the third recitation (DC power outlet pluggably receiving power cord), there is no indication that the generated power is DC and there is certainly no outlet for pluggably receiving a power cord in Sooferian. It is further submitted that combining

Sooferian with Chien, or any other teaching, does not teach or even suggest a need for such a DC outlet since it aims to solve a completely different problem.

Thus, it is concluded that a combination of Sooferian, Chien and Stanford is clearly deficient in establishing a *prima facie* case of obviousness of claim 16.

With respect to the Examiner's remaining rejections of the dependent claims, Applicant submits that since dependent claims 10 to 12 depend either directly or indirectly from independent claim 16, and include all of the limitations of the parent claim. Therefore, the dependent claims are believed to be distinguishable over the cited references for at least the same reasons as those given to parent claim 16.

The Examiner has rejected claims 12, 13 and 16 as being obvious in view of Chien and Stanford. Applicant respectfully traverses this rejection.

Firstly, Applicant submits that having shown that a combination of Sooferian, Chien and Stanford does not teach or suggest all elements of claim 16, it is strongly submitted that a combination of only two of these references, namely Chien and Stanford is even more deficient in teaching or suggesting all of the claim elements.

At any rate, Applicant will address the Examiner's objection as discussed in the Office Action.

The Examiner submits that the embodiment seen in Figure 1C of Chien illustrates a stepping stone in the form of "a massive body". It is drawn to the Examiner's attention that the language of present claim 16 reads "a massive body ... resembling a natural boulder".

Applicant submits that the stepping stone embodiment of Chien is clearly not a "massive body" in the form of a "boulder" as recited in present claim 16. One skilled in the art giving each of the words "massive" and "boulder" its normal dictionary meaning would

not conclude that the stepping stone of Figure 1C of Chien to be a massive body in the form of a boulder.

It is further noted that this embodiment of Chien does not provide any DC outlet. As mentioned above, Chien teaches in Figure 1A that a wire 10 can extend outwardly in one embodiment to power other lights in a series circuit. This is clearly not a DC power outlet as claimed in present claim 16.

It is also noted that present claim 16 recites that the power supply is a “stand-alone” device, not requiring a power cord of its own. In contrast, Chien clearly teaches the use of power from a power outlet (transformer 11 and cord 10’ of Figure 1A of Chien)

The Examiner agrees that Chien does not teach or suggest angling a solar panel at 45°. The Examiner is relying on a combination of Chien and Stanford for this. However, it is submitted that one skilled in the art would not modify Chien to incline the solar panel to 45° based on Stanford. As discussed at length above, Stanford is not even directed to analogous subject-matter – Stanford is directed to a proposal for trails, not garden accessories. Further, Stanford teaches that a 45° slope is not a desirable characteristic.

Applicant is very puzzled as to how Stanford is at all applicable to the present invention. It is strongly submitted that a combination of Chien and Stanford is clearly deficient in teaching or suggesting each and every recitation of claim 16.

With respect to the Examiner’s remaining rejections of the dependent claims, Applicant submits that since dependent claims 10 to 12 depend either directly or indirectly from independent claim 16, and include all of the limitations of the parent claim. Therefore, the dependent claims are believed to be distinguishable over the cited references for at least the same reasons as those given to parent claim 16.

The Examiner has rejected claims 10 to 13 and 16 under 35 U.S.C. § 103(a) as being obvious in view of Chien, US Patent 4,835,664 (Wen) and PG Publication 200301212541 (Hilton). Applicant respectfully traverses this rejection.



Discussing first Chien, the Examiner is relying on Chien to teach the recitation of a DC outlet as recited in claim 16. However, as discussed at length above, Applicant submits that Chien does not even teach the use of a DC power outlet in the power supply. Chien teaches in Figure 1A that a wire 10 can extend outwardly in one embodiment to power other lights in a series circuit. This is clearly not a DC power outlet as claimed in present claim 16.

The Examiner agrees that Chien does not teach the natural rock-like appearance, and is relying on the teachings of Hilton to lead one skilled in the art to modify Chien to add a “rock-like” appearance as taught by Hilton. It is respectfully brought to the Examiner’s attention that it is accepted law that an Examiner provide “some articulated reasoning with some rationale underpinning to support the legal conclusion of obviousness.” (*KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007) at p. 14). An Examiner must “identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does,” (KSR Opinion at p. 15). And, the Examiner must make “explicit” this rationale of “the apparent reason to combine the known elements in the fashion claimed,” including a detailed explanation of “the effects of demands known to the design community or present in the marketplace” and “the background knowledge possessed by a person having ordinary skill in the art.” (KSR Opinion at p. 14).

There is no reason given as to why one skilled in the art would modify Chien based on the teachings of Hilton to provide a power supply having a massive body in the form of a boulder, as required by present claim 16.

The Examiner is further reminded that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Accordingly, it is submitted that a combination of Chien and Hilton cannot be the basis of a *prima facie* case of obviousness. Such a combination does not teach one skilled in the art to modify Chien to provide a “rock-like” appearance. As mentioned above, the present invention has a massive body in the form of a boulder. This provides an advantageous power supply that is stable, portable and of a shape so as to not scare away wildlife and birds. None of the cited documents recognize or appreciate such an advantage. As such, it is submitted that one skilled in the art would not combine Chien and Hilton to modify Chien as a rock-like appearance.

The Examiner also agrees that Chien does not teach the recitation of inclining the solar panel by 45°. The Examiner is relying on a combination of Chien and Wen.

However, Applicant submits that one skilled in the art would not modify Chien to incline the solar panel based on the teachings of Wen. It is noted that present claim 16 actually recites “an exposed flat solar electricity-producing panel located on external surface portion to generate an electrical current in the presence of solar radiation, said flat solar electricity producing panel being angled upwardly at an angle of about 45°, wherein said surface portion is flat to support said solar electricity-producing panel”. This power supply defined in present claim 16 includes elements and interrelation of those elements that do not merely perform the function that each element performs separately.

It is noted that in the “Examination Guidelines for Determining Obviousness Under 35 USC 103 in view of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*” specifically provides that a showing that a claimed invention comprises elements in combination that do not merely perform the function that each element performs separately rebuts a rejection of obviousness.

KSR expressly instructs that it remains legally insufficient to conclude that a claim is obvious just because each feature of a claim can be independently shown in the cited art. (KSR Opinion at p. 14). Thus, it is submitted that the presently claimed invention of claim 16 is not a “predictable use of prior art elements according to their established functions” (KSR Opinion at p. 13).

At any rate, the Examiner has not indicated where in the cited documents, a flat surface portion to support a solar panel inclined at 45° is found. A combination of Chien, Hilton and Wen is clearly deficient in teaching every element recited in the present claims. The differences between this combination and the presently claimed invention are great. Further, there is no reason to modify Chien to arrive at the presently claimed invention. The presently claimed invention recites elements and codependency of those elements to provide advantages not provided by, nor even appreciated by, the cited art. Thus, Applicant submits that claim 16 is distinguishable over a combination of Chien, Hilton and Wen.

With respect to the Examiner's remaining rejections of the dependent claims, Applicant submits that since dependent claims 10 to 12 depend either directly or indirectly from independent claim 16, and include all of the limitations of the parent claim. Therefore, the dependent claims are believed to be distinguishable over the cited references for at least the same reasons as those given to parent claim 16.

#### Summary of patentability of new independent claim 16

The invention of claim 16 provides a highly useful power supply. This power supply defined in claim 16 includes elements and interrelation of those elements that do not merely perform the function that each element performs separately.

The invention of claim 16 provides a power supply having a DC outlet that can pluggably receive a power cord from an external separate. The use of a massive body to support the solar panel means the power supply can easily be moved and oriented as desired, for example to maximize exposure to the sun. The massive body has an irregular shape, but includes a flat external surface portion in the form of a planar face angled upwardly at an angle of about 45°, and on this external surface portion, is the solar panel angled at about 45° which is the median elevation of the sun. For additional efficiency, the power supply defined in claim 16 also includes a rechargeable battery. The power generated therein can be supplied to any external, separate device with a DC power cord via a DC power

outlet. Thus the power supply of the present invention provides a convenient, useful, versatile and efficient way to provide power to any device in a garden. Clearly all of the features of the claimed power supply are codependent to provide a highly useful power supply in the art of gardening and landscaping.

The external appearance of the power supply in the shape of a boulder is highly useful in not scaring away wildlife and birds.

The power supply is also a stand-alone device, not requiring external power for its own operation. Actually, it would be counter productive if the power supply required connection to its own power source, limiting its portability and safety.

Such a device is not taught in any of the cited references. Indeed the benefits of such a device is not even contemplated or appreciated by the cited art.

It is submitted that the Applicant has shown that the claimed invention comprises a combination of elements that do not merely perform the function that each element performs separately and that none of the cited references teach or suggest these elements or the combination of elements to achieve the same device and advantages of the claimed invention. As such, it is submitted that the invention of claim 16 is both novel and unobvious over the cited art.

It is directly drawn to the Examiner's attention that the present invention is a power supply. It is not a self-contained unit for providing light. The invention provides power to any external device via a DC outlet. The power supply in accordance with the invention harness solar power, stores it in a battery and provides it to an external device via a DC outlet. In this way, a need for long power cords/extension cords is negated since the inventive power supply can be situated anywhere. Also the outward appearance as a boulder provides the added benefit of not scaring away wildlife and birds. This is in sharp contrast to all of the documents the Examiner continues to cite.

Chien is a light with one embodiment wherein a wire permits other lights to be connected via a series circuit. Sooferian is a stepping stone that lights up at night. Stanford is a proposal for a trail. Wen is a solar powered light. Hilton is a device that lights up a house number. None of these are devices are a stand-alone power supply having a massive body in the form of a boulder with a DC outlet, as recited by present independent claim 16.


Dependent claims 10 to 12

With respect to the Examiner's remaining rejections of the dependent claims, Applicant submits that since dependent claims 10 to 12 depend either directly or indirectly from independent claim 16, and include all of the limitations of the parent claim. Therefore, the dependent claims are believed to be distinguishable over the cited references for at least the same reasons as those given to parent claim 16.

Accordingly, Applicant respectfully requests a timely Notice of Allowance be issued in this case.

If the Examiner has any questions concerning this application, the Examiner is requested to contact the undersigned at the telephone number of 613-236-9561, extension 302.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'Hetal P. Kushwaha', is written over a horizontal line.

Hetal P. Kushwaha

Registration No. 58,187

MARKS & CLERK

P. O. Box 957, Station B,

Ottawa, Ontario Canada K1P 5S7

Tel: (613) 236-9561